

## REMARKS

### *Claim Status*

Claims 1, 3-17, 19-21, and 23-24 are pending and stand finally rejected. Claims 1, 3-17, and 19-20 stand finally rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 1 and 3-15 stand finally rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1, 3-17, 19-21, and 23-24 stand finally rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0099654 ("Nair") in view of PCT Publication No. WO/14476 ("Reinikainen").

Independent claims 1 and 16 have been amended to remove reference to a "computerized" method and to recite that the donation card is used at the point of sale location of the merchant; claims 1, 16 and 21 have been amended to remove reference to a "donation card that is not a credit card;" and claims 1 and 21 have been amended to recite that the purchaser may select the beneficiary. Claims 3, 23, and 24 have been amended for clarification. No new matter has been added. Upon entry of this Amendment, claims 1, 3-17, 19-21, and 23-24 will remain in the Application.

### *Rejection Under 35 U.S.C. § 101*

Claims 1, 3-17 and 19-20 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter in that the claimed invention is merely an "abstract idea and does not reduce to a practical application in the technological arts." Applicant submits that this rejection is in error as there is no requirement that an application for patent be in the "technological arts." As made clear by the USPTO Board of Patent Appeals and Interferences in *Ex parte Lundgren*, Appeal No. 2003-2088: "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one." Thus, there is no requirement to limit the invention to a "computerized method." The requirement for patent eligibility thus remains that set forth by the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) whereby an application for patent needs to fall within one of the statutory categories of invention and provide a "useful, concrete and tangible result".

The present invention is a statutory "process" under 35 U.S.C. § 101 and further provides the "useful, concrete and tangible" results of calculating an amount that is to be transferred to a beneficiary's account based on the transaction purchase amount from a merchant, the donation percentage for the merchant, and the purchaser identification as provided using a donation program card. The resulting credit to the beneficiary's account clearly has basic utility and is thus "useful" and is "concrete and tangible" in that one skilled in the art may readily determine whether he/she has infringed the method steps by crediting a determined donation amount to the beneficiary's account based on a merchant transaction. *State Street Bank* clearly stands for the notion that such monetary transfer provides a sufficiently "concrete and tangible" result and is thus patentable subject matter. Accordingly, Applicant respectfully request reconsideration and withdrawal of the rejection of claims 1, 3-17 and 19-20 under 35 U.S.C. § 101.

***Rejection Under 35 U.S.C. § 112, second paragraph***

Claims 1 and 3-15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claim 1 has been amended to overcome this rejection by deleting references to a "computerized" method as such is not required to satisfy 35 U.S.C. § 101. *See Ex parte Lundgren*. Also, claim 1 has been amended to clarify that the point of sale location is a point of sale location of the *merchant*. In view of these changes, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 3-15 under 35 U.S.C. § 112, second paragraph.

***Rejection Under 35 U.S.C. § 103(a)***

Claims 1, 3-17, 19-21, and 23-24 stand finally rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0099654 ("Nair") in view of PCT Publication No. WO/14476 ("Reinikainen"). This rejection is respectfully traversed for the reasons given below.

The invention of independent claims 1, 16, and 21, as amended, includes features that are neither disclosed nor suggested by the cited references, either taken alone or in combination. The claimed invention is directed to a method for fundraising that uses a donation program card to identify the purchaser at the point of purchase location of the merchant. The purchaser information is matched with the merchant data and the transaction purchase amount to determine the donation amount based on a predefined donation

percentage. The resulting donation amount is then credited to the account of a beneficiary selectable by the purchaser.

By contrast, Nair discloses a system for providing fundraising via an Internet website. As noted in the previous response, Nair, when faced with the problems associated with fundraising using credit cards (such as the inability to select different beneficiaries), turned to the Internet to solve such problems. As expressly acknowledged by the Examiner, Nair does not disclose using a donation program card to provide purchaser information at the point of sale of the merchant. Applicant further submits that inasmuch as Nair's point of purchase is a single Internet web site for multiple merchants, Nair does not address (and has no reason to do so) the problem of providing purchaser information at a merchant's purchase location and matching such information with the merchant's and beneficiary's information within the system. For such a teaching, the Examiner cited Reinikainen in the Final Rejection.

Reinikainen discloses a fundraising system in which donation cards are distributed to potential donors using newspapers or mail or distributed at stores, financial institutions, public buildings and other establishments. The donation card contains printed information identifying the beneficiary and descriptions of particular programs to which a donation may be applied. The donation card also contains encoded data capable of being read by a conventional computer-based cash register or an automated teller machine. The encoded data identifies the card by number, the beneficiary that is to receive the donation, and optionally the amount of the donation, the establishment that distributed the donation card, and/or the name and address of the donor. If the recipient of the donation card is interested in making a donation, he/she presents the donation card to a computer-based cash register or an automated teller machine, which reads and stores the encoded information from the donation card and collects money from the donor. The collected money is then distributed to the beneficiary.

In contrast with the invention, the donation card disclosed by Reinikainen is used to facilitate direct donations to a beneficiary and in no way is used in connection with a purchase transaction for purposes of transferring a portion of the purchase transaction to the beneficiary. As such, Reinikainen does not collect a transaction purchase amount or any other data at a point of sale, for there is no point of sale. Also, no donation amount needs to be calculated, for the entire amount paid by the user of the Reinikainen donation card goes directly to the indicated beneficiary.

From such teachings, the Examiner suggests that one skilled in the art would receive purchaser identification via a donation program card at a point of sale location as claimed. The Examiner concluded that the donation card taught by Reinikainen could have been used by Nair as an "equivalent identification card" in the system of Nair. Applicant respectfully submits that the Examiner has not established *prima facie* obviousness.

As set forth in M.P.E.P. §§2142-2143.03, in order to establish a *prima facie* case of obviousness, patent examiners are required to establish three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference, or combination of references, must teach or suggest all the claim limitations. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To make a proper obviousness determination, the examiner must "step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." In view of the available factual information, the examiner must make a determination as to whether the claimed invention "as a whole" would have been obvious at that time to a person of ordinary skill in the art. Importantly, a rejection based on these criteria must be based on what is taught in the prior art, not the applicant's disclosure. The applicant's disclosure may not be used as a blueprint from which to construct an obviousness rejection.

As noted above, since Nair discloses a system for Internet purchases only, Nair does not disclose nor have any use for a donation program card. Nair does not expect an Internet purchaser to use a donation program card or any other type of card for that matter to be used to provide data to the Internet web site through which items are purchased. On the contrary, even the credit card information is typed in for purposes of completing the web sale. Similarly, Reinikainen does not suggest that his donation card may be used in connection with merchant transactions to provide percentages of such transactions to a particular beneficiary or that the beneficiary may be selected by the purchaser (donation program card holder). Thus, neither Nair nor Reinikainen provide any suggestion or motivation, nor has the Examiner pointed to knowledge generally available to one of ordinary skill in the art, to combine the teachings of Nair and Reinikainen as proposed by the Examiner. Moreover,

Applicant submits that there is no reasonable expectation of success in combining the teachings of Nair and Reinikainen, for there would have been no reason for one skilled in the art to use the donation card taught by Reinikainen in the Internet based system taught by Nair as there is no reason for providing (and typically no device for reading) identification information from a donation card. Applicant submits that the teachings of Nair and Reinikainen *cannot* in fact be combined as the Examiner suggests.

Inasmuch as there is no specific motivation or suggestion for combining the teachings of Nair and Reinikainen as suggested by the Examiner, and inasmuch as the teachings of the references could not have been combined by one skilled in the art due to the incompatible nature of the disclosures, Applicant submits that the Examiner has failed to establish *prima facie* obviousness. Accordingly, Applicant submits that the cited references, either taken alone or in combination, do not disclose or suggest the features of independent claims 1, 16, or 21. Additionally, given that dependent claims 3-15, 17, 19-20, and 23-24 (which have also been rejected) are dependent on claim 1, 16, or 21, these claims are patentable over the cited references, at least by virtue of their dependency. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1, 3-17, 19-21, and 23-24 under 35 U.S.C. § 103.

One skilled in the art would further appreciate that the donation card taught by Reinikainen provides a means for the beneficiary to solicit donations from potential donors, while the donation program card of the invention is used by the purchaser to enable him/her to specify the recipients of percentages of purchases made by the purchaser. The invention further allows for contracting with a merchant to establish the percentages of transaction proceeds that the merchant is to donate to the beneficiary and to contract with the purchaser to select the beneficiary (claim 16). While prior art credit card systems use a credit card to identify the purchaser, such systems do not allow the purchaser to select beneficiaries or for the donation percentages to be negotiated with the merchants. The invention provides the ability to contract with merchants and to select beneficiaries - benefits that are not taught by the cited prior art nor available using the credit card approaches of the prior art. For these reasons, Applicant does not believe that it is necessary to specify that the donation card is not a credit card. Indeed, the credit card may be used to identify the purchaser. Accordingly,

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claims 1, 3-17, 19-21, and 23-24 are believed to be allowable without limiting the invention to use of a donation card "that is not a credit card."

***Conclusion***

For all of the foregoing reasons, applicant respectfully submits that the application is now in condition for allowance. Reconsideration of the final rejection and an early notice of allowance are respectfully requested. In the event that the examiner cannot allow the present application for any reason, the examiner is encouraged to contact the undersigned attorney, Michael P. Dunnam at (215) 564-8962, to discuss resolution of any remaining issues.

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